



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
WWW.USPTO.GOV

Paper No. None

BEYER WEAVER LLP
P.O. BOX 70250
OAKLAND CA 94612-0250

COPY MAILED

MAR 14 2007

OFFICE OF PETITIONS

In re Application of :
Shigeomi Chono et al. :
Application No. 10/814,110 : DECISION ON PETITION
Filing Date: March 30, 2004 : UNDER 37 C.F.R. §1.78(A)(3)
Attorney Docket No.: YMUCP002 :
Title: LIQUID CRYSTAL FLOW :
FORMING MECHANISM, METHOD OF :
FORMING SAME, AND OBJECT MOVING :
MECHANISM USING LIQUID CRYSTAL :
FLOW :

This is a decision on the petition pursuant to 37 C.F.R. §1.78(a)(3), filed November 13, 2006 to accept an unintentionally delayed claim under 35 U.S.C. §120 for the benefit of priority to the prior-filed international application set forth in the amendment filed with the petition.

The petition is DISMISSED

A petition for acceptance of a claim for late priority under 37 C.F.R. §1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 C.F.R. 1.78(a)(2)(ii). In addition, the petition under 37 C.F.R. 1.78(a)(3) must be accompanied by:

- (1) the reference required by 35 U.S.C. § 120 and 37 C.F.R. §1.78(a)(2)(i) of the prior-filed application, unless previously submitted;
- (2) the surcharge set forth in § 1.17(t); and

- (3) a statement that the entire delay between the date the claim was due under 37 C.F.R. §1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

The petition does not satisfy item (1) above.

The reference has been provided by way of an amendment that cannot be accepted. Petitioner's representative has included an amendment to the specification along with this petition, and both have been presented on the same sheet of paper. For this reason, the petition cannot be accepted, pursuant to 37 C.F.R. §1.4(c), which sets forth, *in toto*:

Since different matters may be considered by different branches or sections of the United States Patent and Trademark Office, each distinct subject, inquiry or order must be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects.

Furthermore, even if the amendment could be accepted as filed, it is improper. The reference to add the above-noted, prior-filed application on page one following the first sentence of the specification is not acceptable as drafted since it improperly incorporates by reference the prior-filed application. An incorporation by reference statement added after an application's filing date is not effective because no new matter can be added to an application after its filing date (see 35 U.S.C. § 132(a)). If an incorporation by reference statement is included in an amendment to the specification to add a benefit claim under 35 U.S.C. §120 after the filing date of the application, the amendment would not be proper. When a benefit claim under 35 U.S.C. §120 is submitted after the filing of an application, the reference to the prior application cannot include an incorporation by reference statement of the prior application. See Dart Industries v. Banner, 636 F.2d 684, 207 USPQ 273 (C.A.D.C. 1980). Note MPEP §§ 201.06(c) and 608.04(b).

Moreover, the amendment fails to comply with the requirements of 37 C.F.R. §1.121 in that the text that is to be added has not been underlined. Furthermore, if Petitioner's representative wishes to amend the priority claim, he may wish to consider the deletion of the improper benefit claim which was submitted via a preliminary amendment to the specification on August 25, 2004.

Before the petition under 37 C.F.R. § 1.78(a)(3) can be granted, a renewed petition and either an Application Data Sheet or an

amendment (complying with the provisions of 37 C.F.R. §§1.76(b)(5) and 1.121) to correct the above matters are required.

It is noted that the electronic file associated with the present application indicates that a final Office action was mailed on November 16, 2006. Entry of an after-final amendment cannot be made as a matter of right. Accordingly, a request for continued examination (RCE) may be required for entry of any amendment filed on renewed petition.

Any reply should include a cover letter entitled "Renewed Petition Under 37 C.F.R. §1.78(a)(3)." This is not a final agency action within the meaning of 5 U.S.C 704. The renewed petition should indicate in a prominent manner that the attorney handling this matter is Paul Shanoski, and may be submitted by mail¹, hand-delivery², or facsimile³.

Petitioner's representative will note that an ADS filed with the application is not required to be signed unless the ADS includes a nonpublication request. 37 C.F.R. §1.33(b) requires that amendments and other papers, except for written assertions pursuant to 37 C.F.R. §1.27(c)(2)(ii), filed in the application must be signed by an appropriate party. Therefore, an ADS or a supplemental ADS filed after the filing of an application must be signed in accordance with 37 C.F.R. §1.33(b).

The general phone number for the Office of Petitions which should be used for status requests is (571) 272-3282. Telephone inquiries regarding this decision should be directed to Senior Attorney Paul Shanoski at (571) 272-3225.



Ira Lazarus
Supervisory Petitions Examiner
Office of Petitions
United States Patent and Trademark Office

1 Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.

2 Customer Window, Randolph Building, 401 Dulany Street, Alexandria, VA, 22314.

3 (571) 273-8300- please note this is a central facsimile number.